



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

m.f

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,871	12/05/2003	Shigeaki Hakusui	2747/103	8488
2101	7590	08/18/2006	EXAMINER	
BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618			SMITH, CREIGHTON H	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/729,871

Applicant(s)

HAKUSUI, SHIGEAKI

Examiner

Creighton H. Smith

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Art Unit: 2614

Due to the discovery of additional prior art, prosecution on the merits is reopened.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11, 12, 16, 17, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al, U.S. Patent Publication #2004/0192292 or Ohta et al, U.S. Patent Publication #2004/0052346.

Chang et al disclose in [0034] allowing a user to place an out-going call with either the PSTN network or Internet-based telephony service (VoIP); allowing a user to receive an incoming call from either network (PSTN/Internet) when already engaged in an outgoing call, and may toggle between calls placed on either or both networks where a 2<sup>nd</sup> PSTN line is available. Chang et al disclose in Figs. 1, 10A, 10B an apparatus (10/150) that is connected to a standard analog phone (11) and also to the Internet (19) via PC (14). Chang et al apparatus allows for phone calls to be placed and received using either PSTN or Internet, [0037]. Fig. 2 of Chang et al shows a telephone interface (39) which is coupled to analog phone (11) via jack (31), and a network interface (38) which is coupled to a communication network such as the Internet, [0044]. In [0044],

Art Unit: 2614

Chang et al further disclose that interface (38) could also include a microcontroller.

Ohta et al disclose an apparatus (10) that is connected to an analog phone (11) and that is also connected to the Internet, Fig. 1 & [0032]. In [0015] Ohta et al disclose the adapter that connects a telephone to a network – such as the Internet, [0014]. In [0023] Ohta et al disclose that the gateway system, i.e., adapter (10) can connect a phone call to either the Internet as VoIP or to the PSTN as a circuit-switched call. In Fig. 3 Ohta et al disclose that the adapter has a network interface (12) and a telephone interface (13). For claim 16, see Chang et al –[0055]. For claim 17, see Chang et al –[0046].

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 13, 14, 15, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al, U.S. Publication #2004/0192292 or Ohta et al, U.S. Publication #2004/0052346 in view of Haserodt '836 or Gallick '359.

Both Haserodt and Gallick teach feature servers (105-Haserodt; 160-Gallick) that contain the specific calling features associated with individual telephone lines. To have similarly provided either Haserodt or Gallick's teaching of providing a telephone line's features that are situated in an Internet telephony's gateway into the apparatus' of either Chang or Ohta would have been obvious to

Art Unit: 2614

a person having ordinary skill in the art. The motivation for making this modification is that a person possessing ordinary skill in the Internet telephony art would have readily realized that to incorporate either Gallick's or Haserodt's feature server in either Chang or Ohta's gateway would have been readily combinable. For claim 3, Haserodt discloses in col. 1, lines 20-40, that telephony features can be provided to computers or terminals on a local area network via a feature server. Telephony features may include, without limitation, features such as call redirection, multiple call appearances (hold, drop, transfer, conference), call center agent features, call center management information features, and calling party information features. A person possessing ordinary skill in this type of art, and with Haserodt's disclosure in front of them would have readily realized that another telephony feature contemplated by Haserodt but not specifically disclosed would be simultaneous ringing of additionally phones.

Any inquiry concerning this communication should be directed to  
Creighton H. Smith at telephone number 571/272-7546.

14 AUG '06



Creighton H Smith  
Primary Examiner  
Art Unit 2614